

Remarks

Applicant has amended Claims 16. No new matter has been entered by such amendments and support for the claim amendments can be throughout the specification. Specifically, support for the amendment to Claim 16 can be found throughout U.S. Patent No. 6,379,383, and specifically at col. 6, ln. 47-55, incorporated by reference into the present application. Applicant respectfully requests entry of the claim amendments.

Argument

Claims 16, 20, 26-28, and 30-37 rejected under 35 U.S.C. §112, first paragraph

The Examiner incorrectly construes Claim 16's "having microstructural properties characteristic of a vacuum deposited metal". The Examiner cites MPEP §2116, which states "[t]he materials on which a process is carried out must be accorded weight in determining the patentability of a process. *Ex parte Leonard*, 187 USPQ 122 (Bd. App. 1974)." Therefore, the Examiner is incorrect in stating that consideration is given to the end product and does not require a vacuum deposition process. The Examiner has not provided any different process by which the microstructural properties may be manufactured that is *characteristic of a vacuum deposited metal*. However, in order to advance prosecution forward, the Applicant has amended Claim 16 to indicate "the vacuum deposited structural elements are fabricated of a metal". Additionally, the applicant has amended Claim 16 to state "a void space intermediate the base and second layers that is enclosed therebetween". Such amendments to Claim 16 render the Examiner's rejection of Claim 16 moot; therefore, Applicant respectfully requests the Examiner to withdraw the rejection of Claims 16, 20, 26-28, and 30-37 under 35 U.S.C. §112, first paragraph, as the claims contain subject matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention.

Claims 16, 20, 26-28, and 30-37 rejected under 35 U.S.C. §103(a) as being unpatentable over Brown (U.S. 6,071,305) in view of Whicher et al. (U.S. 6,938,668)

The Examiner contends that Brown's "second layer is shown shaded to distinguish it from the base layer, both layers being part of structural element 12 which is fully made of metal, both layers are metal". Nonfinal Office Action, Page 6, ¶1. The Examiner is reminded of the BPAI's holding that "Brown does not describe a stent with a metal base layer and a second layer, also made of metal". *Ex parte Boyle*, BPAI 2007-3212, pg. 14, ¶5. As such, Brown in view

Whicher does not contain each and every limitation as to render Claim 16 unpatentable, and Brown in view of Whicher is inappropriate to reject Claims 16, 20, and 26-28. Applicant respectfully requests the Examiner to withdraw the rejection of Claims 16, 20, and 26-28 as unpatentable under Brown in view of Whicher.

Additionally, Whicher does not teach or disclose a “plurality of structural vacuum deposited elements including a complex finished geometry”. Whicher is silent as to a plurality of structural vacuum deposited elements including a complex finished geometry; therefore, Whicher is inappropriate to render Claims 16, 20, and 26-28 unpatentable.

Regarding Claim 30, Whicher does not render Claim 30’s element “metal of the first and second layers has at least one surface thereof having controlled heterogeneities thereupon” unpatentable. The Examiner states that “the claimed controlled heterogeneities are inherent to the deposition process taught by Whicher (the Examiner states that Whicher discloses the same process as the applicant and further discloses controlling the microstructure, such heterogeneities are inherently controlled just as much as they are “controlled by the applicant).” Nonfinal Office Action, Page 7, ¶2. Applicant respectfully disagrees with the Examiner and requests the Examiner to come forth with some evidence that Whicher’s process controls heterogeneities. See MPEP § 2112. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Whicher is silent as to the deposition processes that includes or results in controlled heterogeneities. Moreover, Whicher is not enabling for any deposition process for controlled heterogeneities. None of the examples in Whicher contain any statement or suggestion that the vacuum deposited film is controlled for heterogeneities. Courts have consistently held that, for a prior art reference to anticipate a claimed invention, the prior art reference must be enabling. See *Amgen Inc. v. Hoechst Marion Roussel, Inc.* 314 F.3d 1313, 1354 (Fed. Cir. 2003) (stating that “a claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures

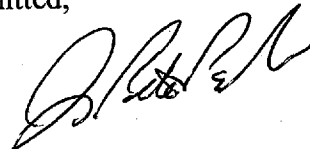
cited as prior art are not enabled ... a non-enabled disclosure cannot be anticipatory (because it is not truly prior art) if the disclosure fails to 'enable one of skill in the art to reduce the disclosed invention to practice' " and quoting from *In re Borst*, 345 F.2d 851, 855 (C.C.P.A. 1962)). For at least these reasons, the Applicant respectfully requests the Examiner to withdraw the rejection of Claims 16, 20, 26-28, and 30-37 as being unpatentable over Brown in view of Whicher.

Conclusion

Accordingly, Applicant submits that the pending claims are patentably distinct from and over the art cited and of record. Favorable reconsideration of the rejection of the pending claims is solicited. Should the Examiner find that there are any outstanding matters, which are susceptible of resolution by telephone interview; the Examiner is invited to telephone the undersigned to discuss the same.

The Director is hereby authorized to deduct a one month fee from Deposit Account No. 18-2000 of which the undersigned is an authorized signatory. The Director is also authorized to deduct any deficiencies in fees and/or charge any credit in fees to Deposit Account No. 18-2000.

Respectfully submitted,



J. Peter Paredes
Reg. No. 57,364

December 1, 2008

Rosenbaum & Associates, P.C.
650 Dundee Road
Suite 380
Northbrook, IL 60062
Tel. 847-770-6000
Fax. 847-770-6006
Email: jparedes@biopatentlaw.com